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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/784,916

02/16/2001

William Grey

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5225

48175

7590

09/13/2005

BMT/IBM

FIVE ELM STREET

NEW CANAAN, CT 06840

EXAMINER

ALPERT, JAMES M

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/784,916

Applicant(s)

GREY ET AL.

Examiner

James Alpert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

HC

### DETAILED ACTION

The application has been examined, and Claims 1-48 are pending. The objections and rejections are as stated below.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter. Specifically the method claims as presented do not claim a technological basis in the pre-ambles and the body of the claim. Without a technological basis, the claims may be interpreted, in an alternative, as involving no more than a manipulation of an abstract idea, and are therefore non-statutory under 35 U.S.C. 101. In contrast, for example, a method claim that includes in the body of the claim a structural / functional interrelationship which can only be computer implemented is considered to have a technological basis [See *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) - used only for content and reasoning since not precedential]. Claims 1-16 relate to methods for obtaining one or more items. However, the preamble and the body of the claims do not indicate that the claims are within the technological arts. To overcome this deficiency, claim language should be considered such that both the preamble and body of the claim indicate that they are grounded within a technological art.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-9,13-25,29-41,45-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Preist, U.S. Patent #6892186.

**With regard to Claims 1, 17, 33,** Preist teaches a method, apparatus, and medium comprising:

identifying a plurality of auctions in which an item is being auctioned; and  
(Col. 21, lines 61-65)

automatically submitting one or more bids to a plurality of the plurality of auctions in order to obtain the item. (Col. 22, lines 16-17)

**With regard to Claims 2, 18, 34,** Preist teaches a method, apparatus, and medium comprising:

identifying one of the plurality of the plurality of auctions having a lowest next bid price for the item, wherein (Col. 22, lines 1-2)

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a next bid price in a particular auction for a particular item is based on a sum of a current bid price for the particular item in the particular auction and a minimum bidding increment associated with the particular auction. (Col. 22, lines 4-8)

**With regard to Claims 3, 19, 35,** Preist teaches a method, apparatus, and medium comprising:

determining whether the lowest next bid price is greater than a maximum bid price; and, (Col. 13, lines 20-29)

if it is determined that the lowest next bid price is not greater than the maximum bid price, submitting to the one auction a bid for the item, the bid being based on the lowest next bid price. (Col. 13, lines 20-29)

**With regard to Claims 4, 20, 36,** Preist teaches a method, apparatus, and medium comprising:

determining whether the lowest next bid price is greater than a maximum bid price; (Col. 13, lines 20-29)

and, if it is determined that the lowest next bid price is greater than a maximum bid price, presenting an indication that the lowest next bid price is greater than the maximum bid price and determining another maximum bid price greater than the lowest next bid price. (Col. 13, lines 20-29)

**With regard to Claims 5, 21,37,** Preist teaches a method, apparatus, and medium comprising:

determining that a submitted bid has been surpassed; and automatically submitting another bid to at least one of the plurality of the plurality of auctions in order to obtain the item. (Col. 14, lines 61-65)

**With regard to Claims 6-8, 22-24,38-40,** Preist teaches a method, apparatus, and medium designed such that upon determining that active bidding has been surpassed, the process of determining the appropriate bidding strategy based on the next lowest bid(s) is repeated. This being the case, the entire procedure ,as laid out in

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the above enumerated claims, are performed in a looped manner, and anticipate said claims.

**With regard to Claims 9, 25, 41,** Preist teaches a method, apparatus, and medium comprising:

withdrawing a previously-submitted bid. (Col. 15, lines 15-25)

**With regard to Claims 13, 29, 45,** Preist teaches a method, apparatus, and medium wherein:

the maximum bid price is based on market factors.

This is an inherent part of the process in Preist. Each determination of maximum bid price will be based on market factors, that is external factors influencing price, as well as individual factors, which include the bidder's real desire for an item.

**With regard to Claims 14-16, 30-32, 46-48,** these claims relate to the various scenarios where one or more bids is placed at one or more, or a plurality of auctions, on one or more, or a plurality of the items desired. The processes in Preist deal with the variety of scenarios contemplated by these claims, in that Preist can be performed with multiple lots or single lots, and in single auctions or multiple auctions. Thus Preist anticipates these claims as well.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10,26,42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Preist, U.S. Patent #6892186. Claims 11-12,27-28,42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Preist in view of Rackson et al, U.S. Patent #6415270.

**With regard to Claims 10, 26, 42,** Preist does not expressly teaches the method, apparatus, and medium comprising:

determining that the bid price of the previously-submitted bid is greater than a sum of a next bid price of one of the plurality of auctions and a cost to withdraw the previously-submitted bid.

However, the examiner takes official notice that withdrawing a bid based on the cost of withdrawing the bid in consideration of the next bid price is old and well known. As such, it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made, given the analysis throughout Preist, which focuses on incremental bidding, to modify Priest to include a withdrawal consideration based on cost. The motivation for such a modification is to reduce the cost of an analysis by including a withdrawal consideration in the next lowest bid process, as opposed to a separate analysis as it currently stands. This would save time and money.

**With regard to Claims 11, 27, 43,** Preist does not expressly teaches the method, apparatus, and medium comprising:  
analyzing at least one of group bidding history and individual bidding history.

However, Rackson does teach this limitation at (Col. 23, lines 6-17). It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to combine the teachings of Preist, relating to the process of considering

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incremental bidding to in order obtain one or more items from one or more auctions, with the teachings of Rackson, relating to the consideration of individual and group bidding history in determining a bid amount. The motivation for such a combination is to include as many variables as possible in determining a certain value will be successful in any randomly selected auction, and further considering timing of auctions. This is suggested in many places in Preist including (Col. 16, lines 1-3).

**With regard to Claims 12, 28, 44,** Preist does not expressly teaches the method, apparatus, and medium wherein:

automatically submitting one or more bids comprises: analyzing at least one of a bidding history for an item similar to the item, a bidding history for items complementary to the item, and a bidding history for items substitutable for the item.

However, Rackson does teach this limitation at (Col. 24, lines 31-51). It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to combine the teachings of Preist, relating to the process of considering incremental bidding to in order obtain one or more items from one or more auctions, with the teachings of Rackson, relating to the consideration of the bidding history in relation to the type of item being auctioned. The motivation for such a combination is to include as many variables as possible in determining a certain value will be successful in any randomly selected auction(s), and further considering timing of an auction(s). This is suggested in many places in Preist including (Col. 16, lines 1-3).

### ***Conclusion***

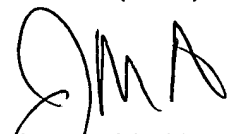
THIS ACTION IS NON-FINAL. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Alpert



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whose telephone number is (571) 272-6738. The examiner can normally be reached on M-F 9:30-6:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.



James M. Alpert  
September 5, 2005

**VINCENT MILLIN**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3600**

